

REMARKS

1. Claims Rejected Under 35 U.S.C. §112, First Paragraph:

The Examiner has rejected claims 1-31 for failing to meet the written description and enablement requirements of 35 USC § 112, first paragraph. This is evidenced by the Examiner's use of MPEP form paragraphs 7.31.01 (written description requirement) and 7.31.03 (enablement requirement) in his rejection. See MPEP § 706.03(c). Specifically, the Examiner states that the limitations in Claims 1, 23, 24, 25 and 31 involving providing of "means through software programming ..." are not sufficiently described in the disclosure to (a) demonstrate possession of the claimed invention at the time of filing to one reasonably skilled in the relevant art; or (b) to enable a person reasonably skilled in the relevant art to practice the claimed invention.

Applicant respectfully disagrees with the examiner and traverses these rejections. Applicant believes the Examiner has failed to present a prima facie case of non-compliance with 35 USC § 112, first paragraph for failure to meet neither the written description requirement nor the enablement requirement. Moreover, even if a prima facie case for either ground of rejection had been set forth by the Examiner, Applicant believes that the disclosure provides ample support for compliance with both the written description and enablement requirements of 35 USC § 112, first paragraph.

A. **The Examiner has failed to present a prima facie case for non-compliance with 35 USC § 112, first paragraph for failure to meet the written description requirement**

The first paragraph of 35 U.S.C. 112 requires that the "specification shall contain a written description of the invention * * *." This requirement is separate and distinct from the enablement requirement. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991). To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *Vas-Cath*, 935 F.2d Id. at 1563. Initially, the Patent and Trademark Office was unwilling to find written descriptive support when the only description was found in the claims; however, this viewpoint has been rejected. See *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980) (original claims constitute their own description). It is now well accepted that a satisfactory description may be

in the claims or any other portion of the originally filed specification. Applicant submits that the specification, including the drawings and claims, of the present application, viewed as a whole, clearly establishes that the Applicant was in possession of the invention as claimed at the time of filing.

An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or diagrams that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406; *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991.)

The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976.) A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

In rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion. These findings must establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. MPEP § 2163.04(I)(B).

In his rejection, the Examiner has failed to overcome the "strong presumption" afforded to applicant that an adequate written description of the claimed invention was present when the application was filed. To wit, the Examiner has altogether failed to set forth any express findings of fact in support of his conclusion that the written description requirement was not met by the present application. More importantly, the Examiner has failed, as expressly required by the MPEP, to provide any reason why a person skilled in the art at the time the application was filed would not have recognized that Applicant was in possession of the invention as claimed in view of the disclosure of the application as filed.

Accordingly, and for the foregoing reasons, the Examiner has failed to establish a prima facie case of insufficiency of a written description under 35 U.S.C. § 112, first paragraph. Applicant, therefore, respectfully requests that this rejection be withdrawn.

B. The Examiner has failed to present a prima facie case for non-compliance with 35 USC § 112, first paragraph for failure to meet the enablement requirement

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent. Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. MPEP § 2164

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) where it held that the requirement was met if the experimentation needed to practice the invention is not undue or unreasonable. That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make

or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.").

Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims. For terms that are not well-known in the art, or for terms that could have more than one meaning, it is necessary that the examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action. See *Genentech v. Wellcome Foundation*, 29 F.3d 1555, 1563-64, 31 USPQ2d 1161, 1167-68 (Fed. Cir. 1994).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971)

As stated by the court in *In re Marzocchi*, 439 F.2d at 224, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." (emphasis in original.) According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments. See also *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981.))

As indicated in MPEP § 2164.04, a rejection for failure to meet the enablement requirement must recite “those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact. For example, doubt may arise about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation. References should be supplied if possible to support a *prima facie* case of lack of enablement, but are not always required. However, specific technical reasons are always required.” (emphasis in original, internal citations omitted)

In addition, the MPEP that with respect to an enablement-based rejection “[t]he principles of compact prosecution also dictate that if an enablement rejection is appropriate and the examiner recognizes limitations that would render the claims enabled, the examiner should note such limitations to applicant as early in the prosecution as possible. In other words, the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application. MPEP § 2164.04

In the instant case, the Examiner’s rejection for failure to meet the enablement requirement of 35 USC § 112, first paragraph, consists, in its entirety, of MPEP form paragraph 7.31.03. The Examiner has failed to provide, as required by the MPEP and above-cited case law, any explanation, much less a reasonable one, as to why he believes the scope of protection provided by the rejected claims is not adequately enabled by Applicant’s disclosure. The Examiner has failed to provide the “factors, reasons, and evidence” which lead the examiner to conclude that the enablement has been met. Such an explanation is expressly mandated by MPEP § 2164.04 as a *de minimis* requirement for an enablement-based rejection under 35 U.S.C. § 112, first paragraph. The Examiner has failed to identify what information, if any, is missing from Applicant’s disclosure or why one skilled in the art could not supply the information without undue experimentation. Finally, the Examiner has failed to provide any references or technical reasons in support of a *prima facie* case of lack of enablement.

Accordingly, and for the foregoing reasons, the Examiner has failed to establish a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph. Applicant, therefore, respectfully requests that this rejection be withdrawn.

C. In any event, the specification meets and exceeds the written description and enablement requirements of 35 USC § 112, first paragraph

Even if the Examiner had established a *prima facie* case for either lack of enablement or insufficiency of the written description of Applicant's disclosure, Applicant respectfully submits that such a rejection would have been improper because both requirements are clearly satisfied by the disclosure.

Within the context of software, which is the specific subject matter raised by the Examiner in his rejection, the Federal Circuit's pronouncement in *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997) is particularly instructive. In that case, the Court stated that "[a]s a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. * * * Thus, flow charts or source code listings are not a requirement for adequately disclosing the functions of software." *Fonar Corp.*, 107 F.3d at 1549.

The rationale of *Fonar* is grounded on the well established principle that a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

Applicant has described in intricate detail the functions of the software aspects of the present invention. In fact, Applicant has gone above and beyond the minimum disclosure described in the *Fonar* opinion by providing flow charts of the functionality of the software aspect of the present invention.

Specifically, with respect to the limitation of Claims 1 and 31 of “providing means through software programming for said retailer members to offer one or more products for sale on said club web site to said consumer members,” Applicant has included a flowchart in Figure 16 of the disclosure detailing the functions of the software that enables retailer members to offer products for sale through the club web site. The flowchart is accompanied by a detailed written description found at page 21, lines 18-29, and at page 37, line 23 through page 38, line 2 of the disclosure.

With respect to the limitation of Claims 1 and 31 of “providing means through software programming for said consumer members to purchase products offered for sale on said club web site,” Applicant has included flowcharts in Figures 8, 9, 10, 11, 18 and 19 of the disclosure detailing the functions of the software that enables consumer members to purchase products for sale through the club web site. The flowcharts are accompanied by a detailed written description beginning on page 26, line 27 and ending on page 34, line 16 of the disclosure.

With respect to the limitation of Claim 1 of “providing means through software programming for said buyer members to be notified of purchases made by said consumer members and to offer to said retailer members to fulfill said purchases,” Applicant has included flowcharts in Figures 12 and 13 of the disclosure detailing the functions of the software that notify buyer members of purchases made by consumer members and enables the buyer members to fulfill the orders. The flowchart is accompanied by a detailed written description found at page 34, line 17 through page 35, line 30, and continued at page 38, line 13 through page 39, line 15 of the disclosure.

With respect to the limitation of Claim 23 of “providing means through software programming for said consumer members to search for products by designating specific retailer members within the same club member area whose products they wish to limit their search to and displaying only products available from the selected retailer members”, Applicant has included a flowchart in Figure 8 of the disclosure which includes an item numbered 845 and labeled “Jump to Retailer.” This is supplemented by the language found in page 29, lines 24-25 which indicates that a consumer member may select a particular retailer by means of a special link. Also provided is a flowchart in Figure 5 of the disclosure which includes items numbered 527 and 520 labeled “Retailer Yellow Pages” and “30 Minute Club” respectively. The flowchart is supplemented by the language found in page 37, lines 7-15 and page 23, lines 27-33 which illustrates how a consumer may be presented with a list of retailer members from which to

choose and how only products sold by the selected retailer members are displayed upon such selection.

With respect to the limitation of Claim 24 of “providing means through software programming for said consumer members to search for products available from said retailer members in the same club member area by selecting a product category”, Applicant has included a flowchart in Figure 5 of the disclosure which includes an item numbered **525** and labeled “Product Categories.” This is supplemented by the language found in page 37, lines 7-15 which illustrates how a consumer may be presented with a list of product categories from which to choose and how products within the selected category are displayed for purchase upon such selection.

With respect to the limitation of Claim 25 of “providing means through software programming for said consumer members to search for products by first preparing a shopping list and then displaying to said consumer member products that match the list which are available from retailer members in the same club member area”, Applicant has included a flowchart in Figure 18 of the disclosure which includes items numbered **1830, 1835, 1837** and **1840** and labeled “Keyword Search”, “Enter Search Text”, “SQL” and “Build Shelf” respectively. This is supplemented by the language found in page 25, lines 18-31 which indicates how a consumer member can locate products within a club member area whose descriptions match a list of keywords. The list of keywords is the functional equivalent of the “shopping list” referenced in Claim 25.

Accordingly, Applicant has demonstrated that the limitations which the examiner rejected on the basis that they did not meet the enablement or written description requirement have been adequately and intricately described in the disclosure to sufficiently (a) demonstrate possession of the claimed invention at the time of filing to one reasonably skilled in the relevant art; and (b) enable a person reasonably skilled in the relevant art to practice the claimed invention.

For the foregoing reasons, Applicant respectfully requests that the Examiner’s rejections be withdrawn and all claims in the subject application be permitted to proceed to allowance

2. Claims Rejected Under 35 U.S.C. §112, Second Paragraph:

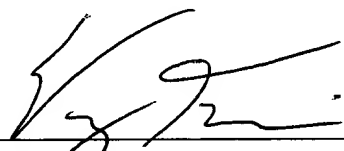
Applicant has amended Claim 17 which, as the Examiner correctly pointed out, was dependent on itself. Applicant has also amended Claims 27 and 28, each of which was also dependent on itself. The incorrect references to parent claims were the result of typographical errors.

CONCLUSION

Applicants submit that this Amendment and Response, if entered, places Claims 1-31 in a condition for allowance and respectfully requests that such action be taken by the Examiner at this time.

Should a telephone conference be necessary to assist the Examiner's evaluation of this application, a telephone call to the undersigned at (305) 448-7089 is respectfully solicited.

Dated: June 8, 2004

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